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UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

REVOLUTION EYEWEAR, INC.)  
a California )  
corporation, )

Plaintiff, )

v. )

ASPEX EYEWEAR, INC., a )  
Delware Corporation; and )  
THIERY IFERGAN, an )  
individual, )

Defendants. )

Case No. CV 02-1087-VAP  
(CWx)

**[Motion filed on May 27,  
2008]**

**ORDER DENYING MOTION FOR  
STAY**

Counterclaim Defendant's Motion for Stay of Execution of Judgment came before the Court for hearing on July 14, 2008. After reviewing and considering all papers filed in support of, and in opposition to, the Motion, as well as the arguments advanced by counsel at the hearing, the Court DENIES the Motion.

**I. BACKGROUND**

On April 30, 2007, the Court granted Counterclaimant Contour Optik, Inc.'s ("Contour") Motion for Partial

1 Summary Judgment on the issue of Infringement, holding  
2 that Counterclaim Defendant Revolution Eyewear, Inc.  
3 ("Revolution") infringed Claim 22 of Contour's Patent No.  
4 RE37,545 ("545 Patent"). (See Order Granting  
5 Counterclaimant's Motion for Summary Judgment on  
6 Infringement, April 30, 2007 ("Infringement MSJ Order").)  
7 On the same day, the Court denied Revolution's Motion for  
8 Partial Summary Judgment on the issue of invalidity,  
9 holding that Revolution had failed to establish that  
10 Claim 22 was invalid. (See Order Denying Counter-  
11 Defendant's Motion for Summary Judgment of Invalidity,  
12 April 30, 2007 ("Invalidity MSJ Order").)

13

14 This case was tried to a jury on September 18, 19, 20  
15 and 21, 2007, on Contour's claim for damages for patent  
16 infringement against Revolution. The jury returned a  
17 verdict awarding damages of \$4,319,530.70 to Contour on  
18 September 21, 2007.

19

20 After trial, the parties submitted briefs on  
21 Revolution's intervening rights defenses. On January 3,  
22 2008, the Court issued a Memorandum and Opinion on  
23 Equitable Issues, Findings of Fact and Conclusions of Law  
24 ("Op. of January 3, 2008"), concluding that Revolution  
25 was entitled to absolute intervening rights and reducing  
26 the damages awarded by the jury by \$125,964.  
27 Accordingly, on February 25, 2008, the Court issued a

28

1 Judgment in favor of Contour awarding damages of  
2 \$4,193,567. On April 24, 2008, the Court denied  
3 Revolution's motions for judgment as a matter of law, for  
4 new trial, and for remittitur. (See Order Denying Motion  
5 for Judgment as a Matter of Law, for New Trial, and for  
6 Remittitur, April 24, 2008 ("Remittitur Order").)

7  
8 On May 27, 2008, Revolution filed this Motion for  
9 Stay of Execution of Judgment Pending Appeal ("Mot.").  
10 Revolution challenges the results of the Invalidity MSJ  
11 Order, the Infringement MSJ Order, and the Remittitur  
12 Order. Contour filed an Opposition ("Opp'n") on June 9,  
13 2008. On June 16, 2008, Revolution filed a Reply.

## 14 15 **II. LEGAL STANDARD**

16 "Stays of monetary judgments are ordinarily sought  
17 under either Fed. R. Civ. P. 62(d) or 62(f)." Acevedo-  
18 Garcia v. Vera-Monroig, 296 F.3d 13, 17 (1st Cir. 2002).  
19 An appellant may obtain a stay as a matter of right by  
20 filing a supersedeas bond. Fed. R. Civ. P. 62(d). In  
21 lieu of a supersedeas bond, a court may allow an  
22 appellant to post alternate forms of security. See  
23 Townsend v. Holman Consulting Corp, 929 F.2d 1503, 1505  
24 n.1 (9th Cir. 1987).

25  
26 A court also has discretion to stay execution of a  
27 judgment pending appeal in unusual circumstances without  
28

1 requiring a bond. See Lightfoot v. Walker, 797 F.2d 505,  
2 506 (7th Cir. 1986). In deciding whether to grant an  
3 unsecured stay, a court evaluates whether either (1)  
4 "[the] defendant's ability to pay is so plain that the  
5 cost of the bond would be a waste of money" or (2) "the  
6 requirement would put the defendant's other creditors in  
7 undue jeopardy." Olympia Equip. v. W. Union Tel. Co.,  
8 786 F.2d 7894, 796 (7th Cir. 1986).

9  
10 Here, however, Revolution makes no mention of Rule 62  
11 or of a supersedeas bond, and makes no attempt to show  
12 that it is entitled to an unsecured stay under the  
13 factors set forth in Olympia Equipment. Instead, both  
14 parties urge the Court to apply a four-factor test set  
15 forth by the Supreme Court in Hilton v. Braunskill. (See  
16 Mot. at 3; Opp'n at 1.)

17  
18 In Hilton, the Supreme Court considered whether to  
19 stay release of a prisoner who had prevailed in a habeas  
20 corpus petition, pending appeal of the district court's  
21 order. The Court stated

22 Under both [Federal Rule of Civil  
23 Procedure 62(c) and Federal Rule of  
24 Appellate Procedure 8(a)], the factors  
25 regulating the issuance of a stay are  
26 generally the same: (1) whether the stay  
27 applicant has made a strong showing that  
28 he is likely to succeed on the merits;  
(2) whether the applicant will be  
irreparably injured absent a stay; (3)  
whether issuance of the stay will  
substantially injure the other parties

1 interested in the proceeding; and (4)  
2 where the public interest lies.

3 Hilton v. Braunskill, 481 U.S. 770, 776 (1987).

4 These four factors thus apply to a determination of  
5 whether to grant a stay under Rule 62(c), which governs  
6 requests to stay or modify an injunction pending appeal.  
7 See Fed. R. Civ. P. 62(c). Here, however, Revolution  
8 requests a stay of a judgment of monetary damages, not a  
9 stay of an injunction.<sup>1</sup> It is not clear that the four  
10 factors listed in Hilton apply to such a request.

11  
12 Many authorities treat the four Hilton factors as  
13 considerations to be applied solely to requests to stay  
14 injunctions. See, e.g., Honeywell Intern., Inc. v.  
15 Universal Avionics Systems Corp., 397 F. Supp. 2d 537,  
16 548 (D. Del. 2005) (stating the four-factor test is the  
17 standard for modifying injunctions under Rule 62(c));  
18 Digital Communications Network, Inc. v. AB Cellular  
19 Holding LLC, 1999 WL 1044234, at \*3 (C.D. Cal. 1999)  
20 (same); Magnesystems, Inc. v. Nikken, Inc., 1994 WL  
21

22 <sup>1</sup> The judgment in this case imposed both monetary damages  
23 and an injunction. (See J., filed February 27, 2007.)  
24 Revolution seeks an order staying execution of the entire  
25 judgment. Its arguments, however, are limited solely to  
26 the damages portion of the judgment. Indeed, it contends  
27 that the injunction is moot, as it has stopped  
28 manufacturing and selling the infringing product. (See  
Mot. at 18.)

1 808421, at \*4 (C.D. Cal. 1994) (same); Wright, Miller &  
2 Kane, Federal Practice and Procedure: Civil 2d, § 2904  
3 (same). Indeed, in a case similar to this one, where the  
4 judgment imposed both monetary damages and an injunction,  
5 the court applied the Hilton factors only to the  
6 injunction portion of the judgment. See In re Hayes  
7 Microcomputer Products, Inc. Patent Litigation, 766 F.  
8 Supp. 818, 822, 829-30 (N.D. Cal. 1991) (staying the  
9 injunction but leaving unaffected the monetary damages  
10 award).

11  
12 Some cases, however, have applied the Hilton factors  
13 in the context of a request for stay of a monetary  
14 judgment under Rule 62(d). In Endress + Hauser, Inc. v.  
15 Hawk Measurement Systems Pty. Ltd., the court held that a  
16 defendant is entitled to a stay under Rule 62(d), even  
17 with a supersedeas bond, only if it first establishes  
18 entitlement to a stay under the Hilton factors. See 932  
19 F. Supp. 1147, 1148 (S.D. Ind. 1996). In L.E.A.  
20 Dynatech, Inc. v. Allina, the court treated the two tests  
21 as alternatives, holding that if an appellant cannot  
22 obtain a supersedeas bond and thus is not entitled to a  
23 stay under Rule 62(d), then alternately it can establish  
24 entitlement to a stay under the Hilton factors. 1994 WL  
25 732001, at \*1-\*2 (Fed. Cir. 1994).

26 ///

27 ///

1 Other courts consider the four Hilton factors when  
2 deciding whether to grant a stay under Rule 62(d) without  
3 a supersedeas bond. See Association of Holocaust Victims  
4 for Restitution of Artwork and Masterpieces v. Bank  
5 Austria Creditanstalt AG, 2005 WL 3099592 (S.D. N.Y.  
6 2005). This approach, however, cannot be reconciled with  
7 the Seventh Circuit approach of granting an unsecured  
8 stay under Rule 62(d) only upon a showing of plain  
9 ability to pay or jeopardy to defendant's creditors. See  
10 Olympia Equip, 786 F.2d at 796.

11  
12 The First Circuit has considered the tension between  
13 Rule 62(d) and the Hilton factors, and has concluded that  
14 stays of monetary judgments are evaluated under Rule  
15 62(d), while stays of injunctive orders are evaluated  
16 using the Hilton factors. See Acevedo-Garcia, 296 F.3d  
17 13, 16-17. In a footnote, however, the Acevedo-Garcia  
18 court conceded that "[i]t is at least arguable that a  
19 monetary judgment may also be stayed under the [Hilton  
20 factors]." Id. at 17 n. 4.

21  
22 The Federal Circuit has stated that the four factors  
23 "always guide [its] discretion to issue a stay pending  
24 appeal." Standard Havens Products, Inc. v. Gencor  
25 Industries Inc., 897 F.2d 511, 512 (Fed. Cir. 1990). In  
26 Standard Havens, the court applied the Hilton factors to  
27 a request to stay execution of a judgment imposing both  
28

1 monetary damages and an injunction. Id. at 515-16. In  
2 at least one other case, however, the Federal Circuit  
3 indicates that if an appellant is entitled to a stay  
4 under Rule 62(d), then it need not establish entitlement  
5 to a stay under the Hilton factors. See L.E.A. Dynatech,  
6 Inc., 1994 WL 732001, at \*1-\*2.

7  
8 Here, the Court need not decide whether Rule 62(d) or  
9 the Hilton factors, or both, state the appropriate test  
10 for deciding whether to stay execution of a monetary  
11 judgment, because Revolution has failed to establish  
12 entitlement to a stay under either standard. Revolution  
13 did not argue that it is entitled to a stay under Rule  
14 62(d), with or without a bond. Nor did it present  
15 evidence that would entitle it to an unsecured Rule 62(d)  
16 stay. See Olympia Equip., 786 F.2d at 796 (listing  
17 factors for granting the motion without a bond).  
18 Additionally, as explained below, Revolution has failed  
19 to establish that it is entitled to a stay under the  
20 Hilton factors.

### 21 22 **III. DISCUSSION**

#### 23 **A. Likelihood of Success on the Merits**

24 Revolution challenges the denial of its motion for  
25 summary judgment on invalidity, the grant of Contour's  
26 motion for summary judgment on infringement, and the  
27 amount of the jury award. It offers five bases for  
28



1 overturning these results on appeal: (1) Claim 22 is  
2 invalid because it fails to comply with 35 U.S.C. § 112 ¶  
3 1; (2) Claim 22 is invalid because it fails to comply  
4 with 35 U.S.C. § 112 ¶ 2; (3) Claim 22 is invalid because  
5 it fails to comply with 35 U.S.C. § 251; (4) Revolution  
6 did not infringe Claim 22; and (5) the damages award was  
7 excessive and not supported by the evidence. (Mot. at  
8 4.)

9  
10 Claim 22 of the '545 Patent claims:

11 An eyeglass device comprising:  
12 a primary spectacle frame for supporting  
13 primary lenses therein and having two  
14 side portion extensions extending  
15 rearwardly therefrom and having a front  
16 side, a rear side, a top side, and a rear  
17 end, each of said rear ends pivotally  
18 coupling a leg configured to conform to a  
19 user at a distal end thereof, each of  
20 said extensions of said primary spectacle  
21 frame further having a projection  
22 attached to each of said rear sides, and  
23 a pair of first magnetic members  
24 respectively secured in said projections,  
25 said first magnetic members capable of  
26 engaging second magnetic members of an  
27 auxiliary spectacle frame so that lenses  
28 of an auxiliary spectacle are located in  
front of said primary lenses.

(See Infringement MSJ Order at 5.)

22  
23 **1. Invalidity Under 35 U.S.C. § 112 ¶ 2**

24 Section 112 ¶ 1 provides,

25 The specification shall contain a written  
26 description of the invention, and of the  
27 manner and process of making and using  
28 it, in such full, clear, concise, and  
exact terms as to enable any person  
skilled in the art to which it pertains,

1           or with which it is most nearly  
2           connected, to make and use the same, and  
3           shall set forth the best mode  
          contemplated by the inventor of carrying  
          out his invention.

4 35 U.S.C. § 112 ¶ 1.

5  
6           Here, Revolution argues that Claim 22 of the '545  
7 Patent fails to comply with the requirements of § 112 ¶ 1  
8 because it exceeds the scope of the written description.  
9 (Mot. at 4.) Specifically, it contends that Claim 22 is  
10 impermissibly broad, because, as construed by the Court,  
11 it is not limited to configurations where the primary  
12 frame stably supports the auxiliary frame. (Mot. at 2,  
13 4-8.) Revolution argues that the written description  
14 consistently limited the invention to a configuration of  
15 a primary eyeglass frame that stably supports the  
16 auxiliary frame. (Mot. at 8.)

17  
18           Revolution cites Gentry Galley v. Berkline Corp., in  
19 which the Federal Circuit held invalid a claim that  
20 exceeded the scope of the patent's written description.  
21 See 134 F.3d 1473, 1479 (Fed. Cir. 1998). In Gentry, the  
22 patent specification described reclining seats of a  
23 sectional sofa with recliner controls located on a  
24 central console, eliminating the need to position  
25 recliners at the exposed ends of sofas. Id. at 1474.  
26 The Federal Circuit held invalid claims that did not  
27 limit the location of recliner controls to a central  
28

1 console. Id. at 1479. It explained "locating the  
2 controls anywhere but on the console is outside the  
3 stated purpose of the invention." Id.

4  
5 Here, the '545 Patent addresses two problems:  
6 previous designs failed to "stably support" the auxiliary  
7 frame on the primary frame, and previous designs suffered  
8 a "great[] decrease" in primary frame strength, caused by  
9 embedding magnetic materials directly in the primary  
10 frame. (Invalidity MSJ Order at 22 (quoting '545 Patent,  
11 col. 1, II. 33-37).) While Claim 22 was not directed to  
12 solving the first problem of stable support, it was  
13 directed to solving the second problem of decreased  
14 strength. The written description solves the decreased  
15 strength problem by housing magnetic members in  
16 projections extending from the rear and side portions of  
17 the primary frame's side extensions. (Id. at 22-23); see  
18 '545 Patent, col. 1, II. 55-62.

19  
20 Thus, unlike the claims invalidated in Gentry, Claim  
21 22 addresses a problem within a stated purpose of the  
22 '545 Patent. Cf. Gentry, 134 F.3d at 1479 (invalidating  
23 claims "outside the stated purpose of the invention").  
24 Moreover, on its face, the written description of the  
25 '545 patent supports Claim 22, by disclosing *both* a novel  
26 auxiliary frame *and* a novel primary frame, each of which  
27 ///

1 addresses a different problem identified in the  
2 specification. (See Invalidity MSJ Order at 23 n.28.)

3  
4 As the Court held in its Invalidity MSJ Order,  
5 Revolution has not met its burden of establishing that  
6 Claim 22 exceeds the scope of the written description of  
7 the '545 patent. Revolution has failed to present any  
8 arguments not considered in the Invalidity MSJ Order, or  
9 to identify any errors in the Court's reasoning.  
10 Accordingly, it has not shown a likelihood of success on  
11 its appeal on the basis of violation of § 112 ¶ 1.

## 12 13 **2. Definiteness**

14 Section 112 ¶ 2 provides,

15 The specification shall conclude with one  
16 or more claims particularly pointing out  
17 and distinctly claiming the subject  
matter which the applicant regards as his  
invention.

18 35 U.S.C. § 112 ¶ 2.

19  
20 Revolution argues that Claim 22 is invalid under §  
21 112 ¶ 2 because it is directed only to the primary frame,  
22 which is not "what the applicant regarded as his  
23 invention." (Mot. at 9.) In its Invalidity MSJ Order,  
24 the Court held that Revolution had "expressly abandoned  
25 this argument." (Invalidity MSJ Order at 25.) Now,  
26 Revolution argues that it did not abandon the argument,  
27 (Mot. at 8-10.), despite its earlier statement that  
28

1 "Revolution does not allege that the claim is indefinite  
2 under § 112, ¶ 2." (See Invalidity MSJ Order at 25 n.  
3 30.)

4  
5 Even assuming it did not expressly abandon its  
6 indefiniteness argument, Revolution has failed to  
7 establish that it is likely to succeed on this issue on  
8 appeal. Indeed, in its Motion, Revolution does not argue  
9 that Claim 22 violates § 112 ¶ 2 as indefinite. Instead,  
10 under a heading purporting to introduce an argument about  
11 definiteness and § 112 ¶ 2, it again argues that Claim 22  
12 exceeds the scope of the patent's written description.  
13 (See Mot. at 8-10.) For instance, it cites In re Kaslow,  
14 707 F.2d 1366, 1375 (Fed. Cir. 1983), where the Federal  
15 Circuit discusses the written description requirement of  
16 § 112 ¶ 1. For the reasons explained above at § A.1,  
17 Revolution has not demonstrated it is likely to succeed  
18 in its argument that Claim 22 violates § 112 ¶ 1.

19  
20 **3. 35 U.S.C. § 251**

21 Section 251 provides for the reissue of patents, and  
22 limits such reissued patents to matter disclosed in the  
23 original patent. 35 U.S.C. § 251. Thus, claims in a  
24 reissue patent may not exceed the scope of the original  
25 patent's written description. In re Amos, 953 F.2d 613,  
26 618 (Fed. Cir. 1991).

27 ///

1 Here, Revolution argues the original '207 Patent  
2 disclosed only auxiliary frames, and thus does not  
3 support Claim 22, which describes a primary frame. (Mot.  
4 at 10-11.) In its Invalidity MSJ Order, the Court  
5 rejected this argument, finding that the invention  
6 disclosed in the '207 Patent encompassed a primary as  
7 well as an auxiliary frame. (See Invalidity MSJ Order at  
8 25-26.) The Order quotes several passages from the  
9 written description of the '207 Patent that describe the  
10 design of a primary frame such as that claimed in Claim  
11 22. (See id.)

12  
13 Again, Revolution fails to present any arguments not  
14 considered in the Invalidity MSJ Order, or to identify  
15 any errors in the Court's reasoning. Accordingly,  
16 Revolution has failed to establish a likelihood of  
17 success on appeal based on invalidity under 35 U.S.C. §  
18 251.

19  
20 **4. Infringement**

21 Revolution offers a series of arguments on the  
22 subject of infringement, all of which amount to a  
23 contention that its primary frames do not infringe Claim  
24 22 because they do not stably support such frames. (See  
25 Mot. at 11-15.) Revolution contends the Court erred in  
26 finding that Revolution's frames infringed Claim 22  
27 because they were "capable of engaging an auxiliary frame  
28

1 so that lenses of an auxiliary spectacle frame are  
2 located in front of the primary lenses." (Id.; see  
3 Infringement MSJ Order at 20.)

4  
5 Specifically, Revolution argues that a frame cannot  
6 infringe Claim 22 unless it is capable of "stably  
7 supporting" a "top-mounted" auxiliary frame, unlike  
8 Revolution's frames. (Mot. at 12-15.) It contends the  
9 Court erred by not applying a "shake test" to determine  
10 whether its frames "stably supported" a top-mounted  
11 frame. (Id.)

12  
13 In its Infringement MSJ Order, the Court found that  
14 Revolution had abandoned its argument that Claim 22  
15 includes a "stable support" limitation. (Infringement  
16 MSJ Order at 20.) Thus, a "shake test" was irrelevant to  
17 whether Revolution infringed Claim 22, as long as its  
18 frames were capable of supporting a top-mounted auxiliary  
19 frame. (Id.)

20  
21 Even assuming Revolution did not expressly abandon  
22 this argument, the Court has concluded that the written  
23 description is not limited to "stably supported"  
24 configurations, and that therefore Claim 22 does not  
25 include such a limitation. See, supra § A.1. Thus, the  
26 Court did not err in refusing to apply a "shake test" to  
27 determine if the configuration was "stably supported."

1 Accordingly, Revolution has failed to establish a  
2 likelihood of success on the merits on its appeal of the  
3 summary judgment of infringement.

4  
5 **5. Excessiveness of the Judgment**

6 The Court previously has considered and rejected  
7 Revolution's contention that the judgment is excessive  
8 and not supported by the evidence. (See Remittitur  
9 Order.) In its Motion, Revolution presents no new  
10 arguments and fails to identify any errors in the Court's  
11 reasons for rejecting its arguments. Accordingly, it is  
12 unlikely to succeed on appeal on this basis.

13  
14 **6. Overall Likelihood of Success**

15 As explained above, Revolution has presented nothing  
16 more than a reiteration of the same arguments it raised  
17 in previous motions for summary judgment and for  
18 remittitur. When faced with such arguments in the  
19 context of a motion for stay pending appeal, the Southern  
20 District of New York denied the motion, explaining

21 the [appellant's] 'strong showing' of  
22 success on the merits consists of nothing  
23 more than a cursory enumeration of the  
24 arguments the defendant plans to raise on  
25 appeal. Although the [appellant] claims  
26 that these arguments raise important  
27 issues of law, it offers not a single  
28 case citation to support this claim but  
instead simply recites certain of its  
factual contentions with which [the  
court] disagreed. Under the adversary  
system, it is counsel's responsibility to  
explain why these points have legal



merit; the Court does not serve as  
counsel's law clerk.

Federal Ins. Co. v. County of Westchester, 921 F. Supp.  
1136, 1139 (S.D.N.Y. 1996). Here, as in County of  
Westchester, Revolution has offered nothing more than a  
" cursory enumeration of the arguments the defendant plans  
to raise on appeal." Id. It fails to explain the legal  
standard that will be applied to its arguments on appeal,  
let alone argue why it has met that standard. See  
Endress + Hauser, Inc. v. Hawk Measurement Systems Pty.  
Ltd., 932 F. Supp. 1147, 1149 (S.D. Ind. 1996) (holding  
that an appellant is not entitled to a stay pending  
appeal when it "mere[ly] recit[es] . . . arguments  
previously made and rejected").

#### **B. Irreparable Injury**

As Revolution has failed to establish any likelihood  
of success on the merits, it is not entitled to a stay  
pending appeal. Id. Additionally, however, Revolution's  
Motion fails because it has failed to establish  
irreparable injury.

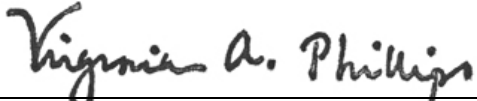
To constitute irreparable harm the  
threatened injury must be, in some way,  
'peculiar.' Mere injuries, however  
substantial, in terms of money, time and  
energy necessarily expended in the  
absence of a stay, are not enough. Only  
harm that the [court] cannot remedy  
following a final determination on the  
merits may constitute irreparable harm.

1 American Hospital Ass'n v. Harris, 625 F.2d 1328,  
2 1331 (7th Cir. 1980). Here, Revolution contends that its  
3 "business will be destroyed" if the Court fails to stay  
4 enforcement of the judgment, but provides no evidence  
5 whatsoever to support this contention. (See Mot. at 17.)  
6 Accordingly, Revolution has failed to meet its burden of  
7 establishing irreparable injury.

8  
9 **IV. CONCLUSION**

10 For the foregoing reasons, the Court DENIES  
11 Revolution's Motion for Stay of Execution of Judgment  
12 Pending Appeal.

13  
14  
15  
16  
17 Dated: July 14, 2008

  
\_\_\_\_\_  
VIRGINIA A. PHILLIPS  
United States District Judge